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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,164	09/13/2000	Dan Kikinis	004688.P021	7516
33448	7590	01/26/2005	EXAMINER	
ROBERT J. DEPKE LEWIS T. STEADMAN			TRAN, HAI V	
HOLLAND & KNIGHT LLC			ART UNIT	
131 SOUTH DEARBORN			PAPER NUMBER	
30TH FLOOR			2611	
CHICAGO, IL 60603			DATE MAILED: 01/26/2005	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/661,164	KIKINIS DAN	
	Examiner	Art Unit	
	Hai Tran	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 09/21/04
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-35 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-35 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.
 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1-35 on September 21st, 2004 have been considered but are moot in view of the new ground(s) of rejection.

Claim Objections

Claim 7 is objected to because of the following informalities: lines 3 limitation "the broadcast stream" should be changed to – the 1st broadcast stream --. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-5, 7, 9-15, 18-24, and 26-30 are rejected under 35 U.S.C. 102(b) as being unpatentable by Mortimer (US 4186413).

Claim 1, Mortimer discloses a system comprising:

A receiver (Fig. 1) to receive a 1st broadcast stream (broadcast program) and a 2nd media (auxiliary message) (Col. 2, lines 45-Col. 3, lines 30); and

A priority indicator (code word) associated with the 2nd media (Col. 2, lines 8-16), the unit permitting automatic insertion of the 2nd media or an indication of the 2nd media into an audio or visual presentation system based on said priority indicators associated with said 2nd media (Col. 2, lines 16-25).

Wherein the automatic insertion is based on the priority indicator and the 1st broadcast stream is not interrupted (Col. 5, lines 55-65+..Col. 7, lines 18).

Claim 2, further discloses wherein the priority indicators associated with the 2nd media comprise numbers, letters or symbols (Col. 2; lines 14-16).

Claim 3, further discloses “wherein the 2nd media and the 1st broadcast stream are the same media” reads on transmitted on the same transmission carrier (Col. 1, lines 49-65+).

Claim 4, further discloses “wherein the 2nd media and the 1st broadcast stream are different media” reads on Television program media and message media.

Claim 5, Mortimer further discloses “wherein an event triggers the 2nd media insertion into the 1st broadcast stream” reads on by detecting of the Code word embedded within the broadcast stream and comparing the embedded Code word with the Code word previously store. If there is a match, the subsequent data words from the auxiliary message is inserted/sync into the received broadcast stream and displayed (Col. 5, lines 55-65+..Col. 7, lines 18).

Claim 7, Mortimer further discloses wherein a signal that is needed to change the priority indicator (code word) of the media insertion is programmed by a time

mark (synchronization; Col. 3, lines 30-60), the time mark synchronizing the 2nd media insertion with the broadcast stream (Col. 5, lines 60-Col. 7, lines 17).

Claim 9, Mortimer further discloses wherein the priority indicators are assigned to the 2nd media insertion by a user of the system (Col. 3, lines 30-43).

Claim 10, Mortimer further discloses wherein the receiver is part of a television system or radio system (see Fig. 1).

Claim 11, Mortimer discloses a method of inserting recorded media into a broadcast stream, the method comprising:

Transmitting a 1st broadcast stream (broadcast program) and a 2nd media (auxiliary message) to a receiver of a broadcast system, the 2nd media having associated with one or more priority indicators (Col. 2, lines 45-Col. 3, lines 30); and

Automatically inserting the 2nd media or an indication of the 2nd media into an audio or video reproduction of the system based on the priority indicator (code word) associated with the 2nd media (Col. 2, lines 8-25); wherein the 2nd media is presented such that no content of the 1st broadcast stream is lost (Col. 5, lines 55-65+..Col. 7, lines 18).

Claim 12 is analyzed with respect to claim 2.

Claim 13 is analyzed with respect to claim 3.

Claim 14 is analyzed with respect to claim 4.

Claim 15 is analyzed with respect to claim 5.

Claim 18, Mortimer further discloses wherein the broadcaster may assign a plurality of priority indicators to different segments of a broadcast stream based on a subdivision or geographic area (i.e., local, regional; Col. 1, lines 60-65+).

Claim 19 is analyzed with respect to claim 7.

Claim 26 is further analyzer with respect to claim 1 in which “a machine readable storage medium tangibly embodying a sequence of instructions executable by the machine to perform a method for inserting recorded media into a broadcast stream” is inherently met by Mortimer because Mortimer shows a system with CPU and memory in which a software must exist in order to perform the function as described.

Claim 27 is analyzed with respect to claim 2.

Claim 28 is analyzed with respect to claim 3.

Claim 29 is analyzed with respect to claim 4.

Claim 30 is analyzed with respect to claim 5.

Claim 33 is analyzed with respect to claim 18.

Claim 34 is analyzed with respect to claim with claim 9.

Claim 35 is analyzed with respect to claim 7.

2. Claims 6, 16, 25 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mortimer (US 4186413) in view of Handelman (US 5414773).

Claim 6, Mortimer does not clearly disclose the 2nd media insertion into the 1st broadcast stream includes notification that an e-mail message has arrived.

Handelman discloses a notification that an e-mail message has arrived on a TV receiver at any channel to which the user is currently tuned (Col. 7, lines 45-50 and Col. 10, lines 25-28). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Mortimer with Handelman so to notify user of new incoming mail while viewing the television program.

Claim 16 is analyzed with respect to claim 6.

Claim 25 is analyzed with respect to claim 6.

Claim 31 is analyzed with respect to claim 6.

3. Claims 8, 17, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mortimer (US 4186413) in view of Bullock et al. (US 5070404).

Claim 8, Mortimer does not disclose using a pilot tone or watermark as priority indicators.

Bullock discloses the use of cue code wherein each cue code comprises four DTMF tones as Indicator (Col. 6, lines 43-Col. 7, lines 25). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hite with Bullock so to take the advantage of the uniqueness of each cue code for determining the presence of the stored data having an identifier corresponding to the cue signal and for providing an indication to the user of the presence of the stored data (Col. 2, lines 1-6).

Claim 17, limitation “the priority indicators are embedded into the broadcast stream using a pilot tone or watermark” is analyzed with respect to claim 8 and Bullock further discloses wherein the broadcaster may assign a plurality of priority indicators to different segments of a broadcast stream (Col. 6, lines 60-65+).

Claim 32, “the priority indicators are embedded into the broadcast stream using a pilot tone or watermark” is analyzed with respect to claim 8 and Bullock further discloses wherein the broadcaster may assign a plurality of additional priority indicators to different segments of a broadcast stream (Col. 6, lines 60-65+).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is 703-308-7372. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher C. Grant can be reached on 703-305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HT:ht
01/21/2005



HAI TRAN
PRIMARY EXAMINER